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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* MAURICE LORETTI,  
RAOUL CHATTOT, and SAVKA DJOKIC

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Appeal 2010-005585  
Application 10/562,368  
Technology Center 1700

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Before CHARLES F. WARREN, JEFFREY T. SMITH, and  
BEVERLY A. FRANKLIN, *Administrative Patent Judges*.

FRANKLIN, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from the Examiner's rejection of claims 1-13 and 17-24. We have jurisdiction under 35 U.S.C. § 6. An oral hearing was held on April 13, 2011.

STATEMENT OF THE CASE

Claims 1 and 6 are representative of the subject matter on appeal and are set forth below:

1. Sterilizable multilayer film for containers containing solutions, suspensions, solids or mixtures for parenteral or enteral nutrition or tube

feeding, optionally in a spatially separated arrangement of the contents, having a tube feeding, optionally in a spatially separated arrangement of the contents, having a three-layered structure with an inner layer being in contact with the content of the container, an intermediate layer and an outer layer facing the environment, said layers optionally connected by tie and/or adhesive layers; wherein:

the oxygen transmission rate at 23 °C through the multilayer film determined by the oxygen transmission of the intermediate layer is less than 0.7 ml/m<sup>2</sup>d;

said inner layer having a thickness of from 30 to 120 µm;

said intermediate layer having a thickness of from 5 to 35 µm and said outer layer having a thickness of from 20 to 40 µm; and

allowing desorption of water absorbed in the intermediate layer during sterilization after said sterilization at 121° C.

6. The multilayer film according to claim 1, having an outer layer comprising polyethylene terephthalate homopolymer and/or polyethylene terephthalate copolymer.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

McKedy	5,262,375	Nov. 16, 1993
Högström	5,741,566	Apr. 21, 1998
Loretti	EP 0 965 443 A1	Dec. 22, 1999

## THE REJECTIONS

1. Claims 1-5, 13, 17, 19, 20, 22, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Loretti.
2. Claims 6, 18, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loretti in view of Högström.
3. Claims 7-12 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loretti in view of McKedy.

### Rejection 1

#### ISSUE

Did the Examiner err in determining that Loretti's multilayer film inherently possesses Appellants' claimed oxygen transmission rate at 23 °C, determined by the oxygen transmission of the intermediate layer, of less than 0.7 ml/m<sup>2</sup>d?

We answer this question in the affirmative and reverse.

#### ANALYSIS (with Findings of Fact and Principles of Law)

Independent claims 1 (multilayer film) and 20 (method for forming a multilayer film) each recite that the multilayer film has an oxygen transmission rate at 23 °C through the multilayer film determined by the oxygen transmission of the intermediate layer of less than 0.7 ml/m<sup>2</sup>d.

We agree with Appellants' position, as set forth on pages 12-13 of their Reply Brief that the Examiner's inherency position is in error. Therein, Appellants correctly point out that the Examiner states that because the structure of the claimed multilayer film and the chemical composition of the claimed multilayer film are identical, the claimed properties would be inherent. However, as Appellants demonstrate in Table 1 on page 9 of the Brief, Loretti's outer layer is polyamide 11 or polyetherblock amide. The Examiner has not demonstrated that this material would result in a multilayer film having the claimed oxygen transmission rate, especially in view of the fact that Appellants' Specification discloses that PET is the material used as the outer layer for the multilayer film. Spec. 9, ll. 13-18 and 12, ll. 22-29. When the Examiner puts forth a finding of inherency, the Examiner must provide enough evidence or scientific reasoning to establish that the Examiner's belief that the property is inherent is a reasonable belief. *Ex parte Levy*, 17 USPQ2d 1461, 1464-65 (BPAI 1990); *Ex parte Skinner*, 2 USPQ2d 1788, 1789 (BPAI 1986). In the instant case, the Examiner has not done so. Hence, we reverse Rejection 1.

Rejections 2 and 3

#### ISSUE

Did the Examiner err in determining that proper motivation exists for utilizing Högström's PET outer layer as the outer layer of the multilayered film of Loretti?

We answer this question in the affirmative and reverse.

ANALYSIS  
(with Findings of Fact and Principles of Law)

We agree with Appellants' position that the Examiner's rejection lacks the requisite motivation to modify Loretti's multilayer film by incorporating the PET outer layer of Högström, and refer to Appellants' arguments as set forth in the paragraph bridging pages 12-13 of the Brief and the paragraph bridging pages 17-26 of the Reply Brief in this regard. We add the following for emphasis.

Högström is directed to a seven layer multilayer film, wherein outer layers A and A' can be made of PET. Högström, col. 5, ll. 10-18 and claim 1. Loretti is directed to a three layer film for the purposes of steam sterilization. Loretti, paras. [0011], [0014], and [0023]. Högström indicates that polypropylene is "especially preferred" as the outer layer if the multilayer film is to be subjected to steam sterilization. Högström, col. 5, ll. 22-25.

The Examiner asserts that it would have been obvious to have used, as the outer layer of Lorretti (which is polyimide 11 or polyetherblock amide), the PET outer layer of Högström, because Högström teaches that such a layer is water and water vapor resistant. Ans. 5, 10. However, we agree with Appellants that the applied art would not have suggested to one of ordinary skill in the art to have selected PET as the outer layer for Loretti's multilayer film in view of Högström's specific teaching to select polypropylene as the outer layer when the multilayer film is to be subjected to steam sterilization (as in Lorretti). We disagree with the Examiner's position as set forth on page 9 of the Answer wherein the Examiner believes

that the broader teaching of Högström (A and A' can be made of PET) is sufficient because of Högström's specific teaching to use polypropylene as the outer layer when the multilayer film is to be subjected to steam sterilization. This, combined with the other reasons discussed by Appellants on pages 17-26 of the Reply Brief, makes it is apparent that the only teaching or suggestion for modifying Loretti in the manner presented by the Examiner to achieve the claimed invention is derived from Appellants' own Specification rather than the applied prior art. Therefore, we conclude that the Examiner's rejection is improperly based upon improper hindsight reasoning. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007) (The fact finder must be aware "of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning"; citing *Graham v. John Deere Co.*, 383 U.S. 1, 36 (1966) (warning against a "temptation to read into the prior art the teachings of the invention in issue")). See also, *W.L. Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1551, 1553 (Fed. Cir. 1983). We, therefore, reverse Rejection 2 and Rejection 3 (the secondary reference applied in Rejection 3 does not cure the deficiencies of the combination of Loretti in view of Högström).

#### CONCLUSIONS OF LAW AND DECISION

Each rejecting is reversed.

REVERSED

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